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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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James P. Lester

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EXAMINER

SIDDIQI, MOHAMMAD A

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/021,752	Applicant(s) LESTER ET AL.	
	Examiner MOHAMMAD A. SIDDIQI	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/11/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 26-32 is/are pending in the application.
- 4a) Of the above claim(s) 12-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 26-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-11 and 26-32 are presented for examination. Claims 12-25 have been withdrawn from the consideration.

2. In view of the Appeal Brief filed on 02/11/2008, have been fully considered and are persuasive, PROSECUTION IS HEREBY REOPENED.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Regarding claims 6, 7, and 31, the phrase "fewer than a substantial number of media items" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-11 and 26-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Day et al. (5,996,015) (Hereinafter Day) in view of Rothman et al. (US 2001/0044851) (Hereinafter Rothman).

7. As per claim 1, Day discloses computer implemented method of delivering digital media items to a one or more of the user electronic devices, the method comprising; delivering to the one or more of the user electronic devices (201, fig 2), via a computer network (105, fig 1) the digital media items in a sequential order from a playlist (col 2, lines 40-44), the playlist indicating a plurality of the digital media items (col 2, lines 40-44) to be delivered and the sequential order for their delivery one or more of the user electronic devices (col 2, lines 40-44; col 4, lines 23-29); receiving one or more requests for at least one digital media item from one or more of the user electronic devices (col 3, line 65 – col 4, line 7); and selectively adding an indication of the requested digital media item to the playlist (dynamically generating the play list, col 4, lines 42-50) on at least one of the user electronic devices if the modified playlist would satisfy a criteria (user can add attributes of assets and these attribute tells server how to serve the request [please see page 11, 4-6 of the specification], col 4, lines 8-22; lines 42-55). Day fails to disclose a playlist would satisfy a set of restrictive criteria. However Rothman discloses a playlist would

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satisfy a set of restrictive criteria (para #0097). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Rothman with Day. The motivation would have been to make the system DMCA Compliant.

8. As per claim 2, the claim is rejected for the same reasons as claim 1, above. In addition, Day discloses the set of restrictive criteria comprises whether the playlist satisfies a set of group preferences (col 4, lines 56-64; col 5, lines 53-60).

9. As per claim 3, the claim is rejected for the same reasons as claim 1, above. In addition, Day discloses the adding comprises inserting a requested media item at a random position in the playlist (items are inserted on-the-fly prior to the end of the stream [page 15, lines 10-11 of the specification], col 6, lines 37-64).

10. As per claim 4, the claim is rejected for the same reasons as claim 1, above. In addition, Day discloses attempting to add the requested media item to a position in the playlist so that the modified playlist satisfies the set of restrictive criteria (user can add attributes of assets and these attribute tells server how to serve the request [please see page 11, 4-6 of the specification], col 4, lines 8-22; lines 42-55; col 5, lines 53-58); and disregarding the request if the requested media item cannot be added to the playlist so that the modified playlist would satisfy the set of restrictive criteria (303, 305, fig 3, col 6,

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lines 14-25, before the item of different operating characteristics' added to the list is converted to satisfy the operating criteria).

11. As per claim 5, the claim is rejected for the same reasons as claim 1, above. In addition, Rothman discloses the set of restrictive criteria comprises whether the playlist complies with the Digital Millennium Copyright Act requirement for obtaining a statutory license (para #0024).

12. As per claim 6, the claim is rejected for the same reasons as claim 1, above. In addition, Day discloses the delivering media items comprises broadcasting media items to one or more of the user electronic devices (col 4, lines 56-64) so that fewer than a substantial number of media items are delivered with an hour of when their was received (real-time, col 6, lines 51-57, please see summary of the invention).

13. As per claim 7, the claim is rejected for the same reasons as claim 1, above. In addition, Day discloses the delivering media items further comprises broadcasting media items to one or more of the user electronic devices so that fewer than a substantial number of media items are delivered at a time that at least one of the user electronic devices who made the request is informed the requested media items will be delivered (col 4, lines 56-64, please see summary of the invention).

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14. As per claim 8, the claim is rejected for the same reasons as claim 1, above. In addition Rothman discloses the delivering media items comprises broadcasting media items to one or more of the user electronic devices so that the media items are delivered in compliance with the Digital Millennium Copyright Act requirement for obtaining a statutory license (para #0024).

15. As per claim 9, the claim is rejected for the same reasons as claim 1, above. In addition, Day discloses providing a searchable database of media items that allows at least one of the user electronic devices to search the database by a set of media attributes (col 3, lines 39-45); receiving a request from one or more of the user electronic devices for a media item from the database (col 3, line 63- col 4, line 2); and selectively adding the requested media item from the database to the playlist if the modified playlist would satisfy the set of restrictive criteria (dynamically generating the play list, col 4, lines 42-50).

16. As per claim 10, the claim is rejected for the same reasons as claim 1, above. In addition, Day discloses the adding comprises limiting the number of requests from at least one of the user electronic devices (selective access, col 5, lines 53-59).

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17. As per claim 11, the claim is rejected for the same reasons as claim 1, above. In addition, Day discloses the media items are sound recordings (MPEG compressed audio, col 3, line 25).

18. As per claim 26, the claim is rejected for the same reasons as claim 1, above. In addition, Day discloses one or more media servers for delivering digital media files to a plurality of client electronic devices over a computer network (fig 2), the one or more media servers comprising:

- a network connection for communicatively coupling one or more of the media servers with the plurality of client electronic devices over the computer network (fig 2, col 2, lines 28-36);

- a playlist memory containing a playlist, wherein the playlist indicates a sequential order to render a set of the digital media files (col 2, lines 40-44; col 4, lines 23-29);

- a media storage memory containing a library of the digital media files (col 3, lines 43-45); and

- a processor coupled with the network connection, the playlist memory (fig 2), and the media storage memory the processor operative (fig 2) to: evaluate requests for digital media files from one or more of the electronic devices using a set of criteria (col 3, line 65 – col 4, line 7),

- upon at least one of the requests would satisfying the set of criteria, add an indication of the requested digital media file to the playlist (dynamically generating the play list, col 4, lines 42-50) ; and

transmit digital media files according to the sequential order indicated by the playlist from the media storage memory to the plurality of client electronic devices over the computer (fig 2, col 2, lines 28-52).

19. As per claim 27, the claim is rejected for the same reasons as claims 26 and 6, above.

20. As per claim 28, the claim is rejected for the same reasons as claims 26 and 2, above.

21. As per claim 29, the claim is rejected for the same reasons as claims 26 and 11, above.

22. As per claim 30, the claim is rejected for the same reasons as claim 1, above. In addition, Rothman discloses the playlist memory contains a plurality of playlists, each playlist corresponding to a network media channel (Multicast, para #0016-#0017); the processor is adapted to receive requests for digital media files from the plurality of client electronic devices (para#0060), each request being associated with a network media channel (para #0074), wherein the processor evaluates each request using one or more restrictive criteria (para #0097) and, if the playlist (para #0073) including the requested media file would satisfy the set of restrictive criteria (para #0097) , adds the requested digital media file to the playlist (para #0097) ; and

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the one or more media servers broadcast digital media files sequentially to the network on each of the plurality of network media channels according to each corresponding playlist (para #0073; para #0074) .

23. As per claim 31, the claim is rejected for the same reasons as claims 26 and 7, above.

24. As per claim 32, Dunning discloses the set of restrictive criteria comprises a set of group preferences to each network media channel.

Response to Arguments

25. Applicant's arguments with respect to claims 1-11 and 26-32 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MOHAMMAD A. SIDDIQI whose telephone number is (571)272-3976. The examiner can normally be reached on Monday -Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nathan J. Flynn/
Supervisory Patent Examiner, Art Unit 2454